

## **REMARKS**

### **I. INTRODUCTION**

Applicants thank the Examiner for participating in an interview with Applicants' attorneys on November 21, 2006 (the "First Interview") and December 19, 2006 (the "Second Interview") to discuss certain possible claim amendments proposed based on points raised in the First Interview. Applicants thank the Examiner for indicating (in the Second Interview) that, based on his preliminary review, each of the independent claims as amended herein are allowable over the prior art of record.

Provided above, please find a claim listing which includes the current amendments to claims 1, 8, 16, 23, 25-27, 29, 30, 32-34, 36-39, 42 and 43, cancellation of claims 2, 6, 9, 12, 18, 19, 24, 28, 31, 34, 40 and 41, and addition of new claims 54-63. Thus claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39 and 42-63 are currently pending in this application. Applicants respectfully assert that the amendments to the claims and the addition of new claims fully comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

### **II. REJECTION UNDER 35 U.S.C. § 103(a) SHOULD BE WITHDRAWN**

Claims 1-53 stand finally rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,877,093 issued to Desai et al. (the "Desai patent"), in view of U.S. Patent No. 6,644,553 issued to Ohki et al. (the "Ohki patent"). (See Final Office Action, page 3, paragraph 4). It is respectfully asserted that the alleged combination of the Desai patent and the Ohki patent fails to teach or suggest the subject matter recited in amended independent claims 1, 8, 16, 23, 30, and 38, and the claims which depend therefrom, as provided in more detail below.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103, not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. *See Northern Telecom, Inc. v. Datapoint Corp.* , 908 F.2d 931, 934 (Fed. Cir.), *cert. denied* 111 S.Ct. 296 (1990); *see In re Bond* , 910 F.2d 831, 834 (Fed. Cir. 1990). "It is improper to use the inventor's disclosure as a road map for selecting and combining prior art disclosures." *See Grain Processing Corp. v. American Maize-Products Corp.* , 840 F.2d 902, 907 (Fed. Cir. 1988). "[T]he reference must be viewed without the benefit of hindsight afforded to the disclosure." *In re Paulsen* , 30 F.3d 1475, 1482 (Fed.Cir. 1994). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The Desai patent describes a transaction processing device and system that is capable of configuring the device or synchronizing software modules of the device remotely using a secure connection. (See Desai patent, col. 3, line 61 through col. 4, line 46; and Fig. 8). The Desai patent further describes a system in which a subscriber accesses a web site of a provider, and selects a terminal to reconfigure. A server then communicates with the terminal, and executes the configuration protocol. (See Desai patent, col. 12, line 56 through col. 13, line 40; and Fig. 8).

The Ohki patent describes a portable IC card terminal that is capable of downloading a required application from a network if the required application is not present in the memory of an inserted IC card or in the card terminal itself. (See Ohki patent, col. 2, lines 9-17; col. 6, lines 18-35; and Fig. 17). According to the Ohki patent, if a required application is not present in the card terminal, the card terminal can ask the user to approve a download of the application. (See

*id.*, Fig. 17, step 1703). Upon approval by the user, the card terminal can then download the application through a network. (See Ohki patent, col. 6, lines 27-30; and Fig. 17, step 1704).

The Ohki patent also describes a system that is capable of providing a “version-up” of an application (e.g., changing the version of an application) on an IC card and/or an IC card terminal following a request from the user at the terminal for the “version-up.” (See the Ohki patent, col. 6, line 63 through col. 7, line 23; and Fig. 19). After the request for a “version-up” is made at the terminal, the version of the application is sent from the card terminal to a host processing unit over a network; the host processing unit checks if the received application is an old version and, if so, it sends a newer version to the card terminal. (See Ohki patent, col. 6, line 63 through col. 7, line 19; and Fig. 19, steps 1901, 1904, 1908 and 1910).

A. Claims 1, 3-5, 7, 23, 25-27, 29, 45, 46, 50, 51, 54, 57, 60 and 62

It is respectfully asserted that the alleged combination of the Desai patent and Ohki patent fails to teach or suggest a method for downloading an application to a card terminal in which, *inter alia*, **a request to download an application is received from a remote network connection using a processing arrangement, the card terminal is monitored using the processing arrangement, an activity performed at the card terminal is detected and, based on the detection, information related to the request is electronically transmitted to the card terminal**, as recited in amended independent claim 1. Amended independent claim 23 relates to an apparatus which recites similar subject matter.

In contrast, Applicants respectfully submit that the Desai patent does not teach or suggest, much less disclose, *inter alia*, any monitoring of a terminal, detecting of an activity performed at the terminal relating to the request or, based on the detection of an activity,

electronically transmitting information relating to the request to the terminal as recited in amended independent claims 1 and 23.

The Ohki patent does not cure at least these deficiencies of the Desai patent to teach or suggest the subject matter recited in amended independent claims 1 and 23. As described above, the Ohki patent describes that a card terminal can request a download or an update of an application upon request or approval by a user at the terminal. However, the Ohki patent fails to cure the Desai patent to teach or suggest the combination of a receipt of a request from a remote network location to download an application using a processing arrangement, a detection of an activity at the card terminal or, based on a detection of an activity, a transmission of information relating to the request to the card terminal. Thus, the alleged combination of the Desai and Ohki patents fails to teach or suggest Applicants' invention as recited in amended independent claims 1 and 23.

Claims 3-5, 7, 45, 46, 54 and 60 depend from amended independent claim 1, and claims 25-27, 29, 50, 51, 57 and 62 depend from amended independent claim 23. Thus, Applicants respectfully assert that these claims are also not taught or suggested by the alleged combination of the Desai and Ohki patents for at least the reasons provided above with reference to amended independent claims 1 and 23.

Thus, for at least the reasons provided above, Applicants respectfully assert that claims 1, 3-5, 7, 23, 25-27, 29, 45, 46, 50, 51, 54, 57, 60 and 62 are allowable over the alleged combination of the Desai and Ohki patents, and request that the rejection of claims 1, 3-5, 7, 23, 25-27, 29, 45, 46, 50 and 51 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicants respectfully assert that the alleged combination of the Desai and Ohki patents would likely describe a system that is inconsistent with respect to the teaching of

each of those publications. As noted above, the Desai patent describes receiving a request from a subscriber **via a web site** to configure a terminal, whereas the Ohki patent describes receiving a request from a user **through the card terminal itself** to download or update an application.

B. Claims 8, 10, 11, 13-15, 30, 32, 33, 35-37, 47, 52, 55, 58, 61 and 63

It is respectfully asserted that the alleged combination of the Desai patent and Ohki patent fails to teach or suggest a method for providing configuration data to a card terminal in which, *inter alia*, **information relating to configuring a card terminal using a processing arrangement is received from a remote network connection, the card terminal is monitored using the processing arrangement, an activity performed at the card terminal is detected and, based on the detection, configuration data is electronically transmitted to the card terminal using the processing arrangement**, as recited in amended independent claim 8. Amended independent claim 30 relates to an apparatus which recites similar subject matter.

In contrast, Applicants respectfully submit that the Desai patent does not teach or suggest, much less disclose, *inter alia*, any monitoring of a terminal, detection of an activity performed at the card terminal or, based on the detection of an activity, electronically transmitting configuration data to the card terminal as recited in amended independent claims 8 and 30.

Again, the Ohki patent cited by the Examiner does not cure at least these deficiencies of the Desai patent to teach or suggest the subject matter recited in amended independent claims 8 and 30. As described above, the Ohki patent describes that a card terminal can request a download or an update of an application upon request or approval by a user at the terminal. However, the Ohki patent fails to cure the Desai patent to teach or suggest the combination of a receipt of information from a remote network location relating to configuring a card terminal, a

detection of an activity at the card terminal and, based on the detection, a transmission of configuration data to the card terminal. Thus, the alleged combination of the Desai and Ohki patents fails to teach or suggest Applicants' invention as recited in amended independent claims 8 and 30.

Claims 10, 11, 13-15, 47, 55 and 61 depend from amended independent claim 8, and claims 32, 33, 35-37, 52, 58 and 63 depend from amended independent claim 30. Thus, Applicants respectfully assert that these claims are also not taught or suggested by the alleged combination of the Desai and Ohki patents for at least the reasons provided above with reference to amended independent claims 8 and 30.

Thus, for at least the reasons provided above, Applicants respectfully assert that claims 8, 10, 11, 13-15, 30, 32, 33, 35-37, 47, 52, 55, 58, 61 and 63 are allowable over the alleged combination of the Desai and Ohki patents, and request that the rejection of claims 8, 10, 11, 13-15, 30, 32, 33, 35-37, 47 and 52 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicants respectfully reassert that the alleged combination of the Desai and Ohki patents would likely describe a system that is inconsistent with respect to the teaching of each of those publications, as noted above.

C. Claims 16, 17, 20-22, 38, 39, 42-44, 48, 49, 53, 56, and 59

Applicants' invention, as recited in amended independent claim 16, relates to a method for providing information to a remote network in which, *inter alia*, **a card terminal is monitored using a processing arrangement, an activity performed at the card terminal is detected and, based on the detection, information relating to the activity is generated for network transmission and display**, as recited in amended independent claim 16. Amended independent claim 38 relates to an apparatus which recites similar subject matter.

In contrast, Applicants respectfully submit that the Desai patent does not teach or suggest, much less disclose, *inter alia*, any monitoring of a terminal, detection of an activity performed at the card terminal or, based on the detection of an activity, generating information relating to the activity for network transmission and display as recited in amended independent claims 16 and 38.

Again, the Ohki patent cited by the Examiner does not cure at least these deficiencies of the Desai patent to teach or suggest the subject matter recited in amended independent claims 16 and 38. As described above, the Ohki patent describes that a card terminal can request a download or an update of an application upon request or approval by a user at the terminal. However, the Ohki patent fails to cure the Desai patent to teach or suggest the combination of a monitoring of a terminal, a detection of an activity performed at the card terminal or, based on the detection of an activity, a generation of information relating to the activity for network transmission and display. Thus, the alleged combination of the Ohki and the Desai patent fails to teach or suggest Applicants' invention as recited in amended independent claims 16 and 38.

Claims 17, 20-22, 48, 49 and 56 depend from amended independent claim 16, and claims 39, 42-44, 53 and 59 depend from amended independent claim 38. Thus, Applicants respectfully assert that these claims are also not taught or suggested by the alleged combination of the Desai and Ohki patents for at least the reasons provided above with reference to amended independent claims 16 and 38.

Thus, for at least the reasons provided above, Applicants respectfully assert that claims 16, 17, 20-22, 38, 39, 42-44, 48, 49, 53, 56 and 59 are allowable over the alleged combination of the Desai and Ohki patents, and request that the rejection of claims 16, 17, 20-22, 38, 39, 42-44, 48, 49 and 53 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicants respectfully reassert that the alleged combination of the Desai and Ohki patents would likely describe a system that is inconsistent with respect to the teaching of each of those publications, as noted above.

D. Claims 5, 47, 49 and 51-53

Further, with respect to claims 5, 47, 49 and 51-53, Applicants respectfully additionally assert that the alleged combination of the Desai and Ohki patents fails to teach or suggest any **detection of a command to close a batch at a card terminal**, much less any transmission of information related to a request upon such detection, as recited in these claims. Thus, for at least these additional reasons, Applicants again assert that claims 47, 49 and 51-53 are allowable over the alleged combination of references relied on by the Examiner, and request that the rejection of claims 47, 49 and 51-53 under 35 U.S.C. § 103(a) be withdrawn.

**III. CONCLUSION**

In light of the foregoing, Applicants respectfully submit that pending claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39 and 42-67 are in condition for allowance. Prompt consideration, reconsideration and allowance of all of the claimed of the present application are therefore earnestly solicited. If any issues remain outstanding, the Examiner is invited to contact the undersigned via the telephone number provided below.



Respectfully submitted,

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